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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,292	04/02/1999	DONNA G. ALBERTSON	023070-09140	3543

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EXAMINER

HARRIS, ALANA M

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 09/27/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/285,292

Applicant(s)

ALBERTSON ET AL.

Examiner

Alana M. Harris, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-31 is/are allowed.
- 6) ☒ Claim(s) 18-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. Claims 1-32 are pending.  
Claims 1-32 are examined on the merits.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Withdrawn Rejection***

***Claim Rejections - 35 USC § 112***

3. The rejection of claims 15 and 30 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of Applicants' arguments.

***Maintained Rejection***

***Claim Rejections - 35 USC § 112***

4. The rejection of claims 18-32 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention is maintained.

Applicants present arguments that shed light on the link between CYP24 expression level and cancer survival expectancy and direct the Examiner's attention to

specific passages within the specification that support these arguments. These arguments have been considered but found unpersuasive.

As stated in the Office Action (Paper number 19) mailed December 18, 2001, page 4, "the specification does not provided any objective evidence that supports the estimation of survival expectancy." Applicants' arguments and assertions do not clarify the role of *CYP24* as a marker capable of definitely evaluating the survival expectancy of an animal with cancer. Applicants' claims read on the use of *CYP24* as a prognostic marker capable of determining cancer patient survival. As stated in Paper number 19 the claims are not enabled because there is insufficient evidence provided within the specification regarding the predictability of cancer prognoses and the estimation of life expectancies within a population with a disease or disorder utilizing the levels of *CYP24*. The specification provides neither guidance on nor exemplification of how to correlate the level of *CYP24* with the ability to provide a prognostic evaluation of a patient suspected of exhibiting an increased level of *CYP24* in a cancer patient sample.

Tockman et al. (Cancer Research 52:2711s-2718s, 1992) teach considerations necessary for a suspected cancer biomarker (intermediate end point marker) to have efficacy and success in a clinical application. Although the reference is drawn to biomarkers for early lung cancer detection, the basic principles taught are clearly applicable to other oncogenic disorders. Tockman teaches that prior to the successful application of newly described markers, research must validate the markers against acknowledged disease end points, establish quantitative criteria for marker presence/absence and confirm marker predictive value in prospective population trials,

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see abstract. Early stage markers of carcinogenesis have clear biological plausibility as markers of preclinical cancer and **if validated** (emphasis added) can be used for population screening (p. 2713s, column 1). The reference further teaches that once selected, the sensitivity and specificity of the biomarker must be validated to a known (histology/cytology-confirmed) cancer outcome. The essential element of the validation of an early detection marker is the ability to test the marker on clinical material obtained from subjects monitored in advance of clinical cancer and *link* those marker results with subsequent histological confirmation of disease. "This irrefutable link between antecedent marker and subsequent acknowledged disease is the essence of a valid intermediate end point [marker]", see page 2714s, column 1, Biomarker Validation against Acknowledged Disease End Points section. Clearly, prior to the successful application of newly described markers, markers must be validated against acknowledged disease end points and the marker predictive value must be confirmed in prospective population trials, see page 2716s, column 2, Summary section. Tockman reiterates that the predictability of the art in regards to cancer prognosis and the estimation of life expectancies within a population with a disease or disorder is highly speculative and unpredictable.

In view of the analysis and teachings above, and the lack of guidance and or exemplify in the specification, it would not be predictable that the method would function as contemplated. Thus, it would require undue experimentation by one of skill in the art to practice the invention as claimed.

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5. Claims 1-32 are free of the art.

***Allowable Subject Matter***

6. Claims 1-17 are allowed.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (703) 306-5880. The examiner can normally be reached on 6:30 am to 4:00 pm, with alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4315 for regular communications and (703) 308-4315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

Alana M. Harris, Ph.D.  
September 17, 2002

  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600